

Appl. No. 10/800,294

Amdt. Dated: Oct. 6, 2005

Reply to Office Action of: July 21, 2005 and Advisory Action of: September 28, 2005

### REMARKS

This correspondence is in response to USPTO Final Office Action of mail date 07/21/2005 and Advisory Action of mail date 09/28/2005. Applicant notes that it submitted two proposed, after-final amendments dated August 22, 2005 and September 15, 2005, neither of which were entered. Applicant requests that these unentered amendments **remain unentered**.

### Specification

The amendment filed 04/25/2005 is objected to under 35 U.S.C 132(a). Examiner points out the added material which is not supported by the original disclosure is as follows: the identification of US application 09/871,608 and the patent application publication 2002/0028112 on page 2 in the amendment to the specification are not supported by the original disclosure. Further, the term "incorporated herein by reference" on page 3 in the amendment to the specification cannot be used when those same documents were not originally identified. Also, there was no indication that the document, NO 304839, was to be incorporated into the specification.

Examiner requires the Applicant to cancel the new matter, so the Applicant amends the specification to delete those documents.

The disclosure is objected to because of the following informalities: the type of document being identified by " NO 304839" is not defined, i.e., patent application or patent. Further, the deletion of "GB 1571327 (DE 2700378)" at page 4, line 3, needs to be added and indicate that the US 4,068,963 corresponds to these patents.

The Applicant herein amends the specification as Examiner's suggestion to cure the objection.

### Priority

The present application claims the benefit of a previously filed application under 35 U.S.C. Section 120. Examiner points out the reference must include the relationship and the

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current status of all non-provisional parent applications. The Applicant herein amends the first sentence of the specification of this application to include the relationship and the current status of parent application. All certified copies of the priority documents had been submitted in the parent application No. 09/871,609.

### **Claim Objections**

Claims 12-14, 16-19 and 22 are objected to because of the following informalities:

regarding claims 12-14 and 16-19, these claims need must contain a reference to a claim previously set forth; claims 22 and 23 are not previously set forth claims;

regarding claim 12, "same one said" in line 2 should be deleted; and

regarding claim 22, "each" in line 9 should be deleted as there is only one conical hole and not respective conical holes.

For curing the objection, claims 12-14 and 16-19 are canceled and rewritten into claims 26-32, and therefore, claims 22 and 23 are now previously set forth claims. The amendment of claims 12 and 22 requested by Examiner is also made.

### **Claims Rejections - 35 USC §112 Second Paragraph**

The Office rejected Claims 12-14 and 22-24 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. A §112 second paragraph rejection has two separate requirements, indefiniteness and failing to claim what applicant regards as the invention. With respect to indefiniteness, the "essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of (1) the content of the particular disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." (MPEP §2173.02).

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Regarding claim 12, the limitation "strands are anchored in their respective holes" is rejected as being indefinite referring to claim 22. The Applicant now amends claim 12, which is rewritten into claim 26 now, into "said strand is anchored in said respective hole" to distinctly define the limitation.

Claims 22-24 are rejected because of the metes and bounds of the claim is unclear. The Applicant now amends claims 22-24 to cure the rejection. In claims 22-24, the amendment "a termination of a tension member, in which said tension member comprises multiple strands" distinctly defines the limitation. The tension member consists of strands, and the purpose of the claimed structure defined by the preamble as the "termination of one end of a tension member" is clear.

**Claim Rejections – 35 USC § 103**

The Office has quoted the statute from 35 USC 103(a), which is referenced herein. The Office has rejected claim 11 as being unpatentable over Flory, 5,611,636, in view of Brandestini, 4,068,963. The Office has rejected claims 11-13 as being unpatentable over Paulshus, NO304438, in view of Brandestini. Applicant has carefully considered the Office rejections and respectfully submits that the rejection is improper. The applicant traverses this rejection as supported by the arguments herein.

Claim 11 was canceled in the amendment filed 04/25/2005 and no longer pending, therefore the rejection of claim 11 is improper and should be withdrawn.

Claims 12-13, which are herein rewritten into claims 26-27, are dependent claims based on claim 22. According to MPEP 2143.03, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The independent claim 22 is not rejected under 35 U.S.C. 103 and should be assumed non-obvious. The dependent claims therefrom should be also non-obvious according to MPEP 2143.03, so the rejection of claims 12-13 is improper.

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Claim 22 was not rejected under 35 U.S.C. 103; however Applicant herein respectfully explains the differences between currently amended claim 22 and the references to support the withdrawal of the rejection of claims 12-13.

In claim 22, one of the limitations is "said strands comprising fibers selected from the group consisting of carbon fibers, aramid fibers, and glass fibers", but Flory only disclosed "fibers, wires, and carbon rods". Flory, Brandestini and NO patent 304438 all fail to disclose or suggest the use of "carbon fibers, aramid fibers, and glass fibers". According to the MPEP §2143.01, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art." Therefore, this limitation in claim 22 is non-obvious, and claims 12-13 depending therefrom should be also non-obvious.

Another limitation in claim 22 is "said strands having a lower shear force and durability than steel". None of the references disclosed the shear force information of the strands, so claim 22 is non-obvious and claims 12-13 depending therefrom should be also non-obvious.

Yet another limitation in claim 22 is "each strand inserted into the *narrow end* of a respective *conical hole* and fixed in relation to the hole by a hardened mass; and the wall of said conical hole having a slip agent applied thereto". It is readily apparent by comparison of this specification to the reference that the conical hole of this claim is **not** the guide section bore of Brandestini, which is oriented in reverse of the claimed conical hole with its *large end* directed towards the tension member, and where strands are inserted into the *large end* of the guide section in stark distinction to the limitation of claim 22. Brandestini all figures and text at col 2, line 46: "The support body 5 forms *at the wall of the guide bore 8 a support surface 8a* which is provided with a suitable friction-reducing agent or means..." Brandestini's conical guide bore 8 is oriented opposite in direction to his conical anchor bore 2 which is the analogous structure to that of claim 22, and for which there is no suggestion of using a slip agent as is required by claim 22.

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Adding Brandestini to Flory simply adds structure that is not relevant to, not present, and not suggestive of the limitation of claim 22. Applicant asks what teaching, motivation or suggestion is there in the Flory/Brandestini combination for putting a slip agent on Brandestini's conical bore 2, or the wall of Flory's socket 10? Applicant can find none.

**Allowable Subject Matter**

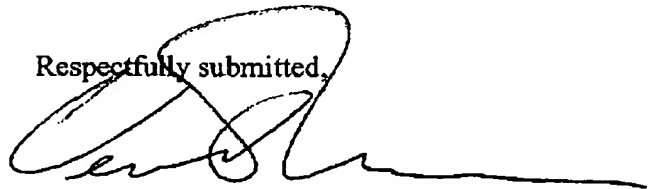
Applicant gratefully acknowledges the allowance of claim 25, and the indication of allowable subject matter of claims 14, 16-19, 23 and 24, which have been herein amended or replaced as appropriate to cure the defects, and remarked thereon above, and are asserted to now be in condition for allowance.

**Request for Allowance**

Applicant believes the above amendments and remarks to be fully responsive to the Office Action, thereby placing this application in condition for allowance. No new matter is added. Applicant requests speedy reconsideration, and further requests that Examiner contact its attorney by telephone, facsimile, or email for quickest resolution, if there are any remaining issues.

This RCE is being submitted in good faith and is a bona fide attempt to advance the application pursuant to 37 CFR 1.111.

Respectfully submitted,



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